

Application No. 08/551198
Amendment Dated: February 9, 2006
Reply to Office Action of August 9, 2005

REMARKS

In response to the Office Action mailed August 9, 2005, Applicant respectfully requests reconsideration.

Claims 35-46 were previously pending in this application. By this amendment, Applicant amends claims 35 and 46 solely for clarification, and adds claims 47-???. As a result, claims 35-?? are pending for examination, of which claim 35 is independent. No new matter has been added.

1. Double Patenting Rejections

Claims 35-45 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over specified claims of U.S. Patent Nos. 6,406,036, 6,088,722, 6,020,883, 5,838,087, 5,754,939, 5,754,938. Applicants respectfully disagree, as each of claims 35-45 are patentably distinct from each of the claims recited in each of the above patents.

Further, claims 35-40 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of co-pending Application No. 10/262,123. Applicants note that these rejections are provisional and therefore do not require a response at this time. However, Applicants expressly reserve the right to respond to these rejections at a future time.

2. Claim 35 as Amended Overcomes the Claim Objection

Claim 35 has been amended as shown above to correct the “typographical error” specified in the Office Action. Accordingly, Applicants respectfully request that the objection to claim 35 be withdrawn.

3. Claims 35 and 46 as Amended Satisfy the Requirements of Section 112

In response to the rejections of claims 35 and 46 under 35 U.S.C. §112, second paragraph, Applicants have amended claim 35 to provide the proper antecedent basis, and have amended claim 46 to recite proper dependency to claim 44. In view of the foregoing, Applicants

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respectfully request that the rejections of claims 35 and 46 under Section 112, second paragraph, be withdrawn.

4. Claims 35-46 Patentably Distinguish Over Dedrick

Claim 35 stands rejected under 35 U.S.C. §103(a) as purportedly being unpatentably over U.S. Patent No. 5717923 (Dedrick). Applicants respectfully traverse this rejection.

Preliminarily, Applicants respectfully submit that this rejection does not satisfy the following examination standards set forth in The Manual of Patent Examining Procedure (MPEP)::

“The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.”

MPEP Section 706, 700-17, first column

“It is important for an Examiner to properly communicate the basis for a rejection so that the issues can be identified early and the Applicant can be given fair opportunity to reply.” **MPEP Section 706.02(j), 700-31, second column**

The rejection does not even mention every feature of claim 35. Namely, it is silent with respect to steps (e)(2), (f) and (g). Consequently, it has proved difficult to understand the basis of the rejection set forth in the Office Action, which leaves the Applicants guessing as to the basis for finding the claimed subject matter to be obvious. Nonetheless, in order to further prosecution, Applicants have made herein a good faith effort to try to understand and respond to the rejection. Applicants request that, if the Examiner ‘s understanding of Dedrick differs from Applicants’ and the Examiner continues to believe that the claims are unpatentable over Dedrick, that the Examiner issue a new, non-final Office Action addressing each and every feature of the claims.

Dedrick is directed to dynamically customizing electronic information to individual end users. A personal profile database in a client system stores consumer information corresponding to individual end users of the client system. The client system includes a content adapter that compares electronic information received by the client system to the consumer information in the

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personal profile database and customizes the electronic information to an individual end user based on this comparison. (Col. 2, lines 1-11).

The system includes a publisher-advertiser 18 with software tools to create electronic information which includes content and advertisements that can be transmitted over the system. The electronic information may allow an end user to access a content database, or the information may be all or a portion of a content database. The content database may be the text and video of an electronic newspaper. (col. 4, lines 11-17). The publisher-advertiser 18 is provided with software tools to create electronic information in a wide variety of consumption formats that can be transmitted over the system. These consumption formats include formats such as audio, video, graphics, animation, texts, etc. (col. 4, lines 44-48). The publisher-advertiser 18 may be provided with a software tool to embed consumer variables in the electronic variables, to enable monitoring of consumer interaction with the electronic information. (Col. 4, lines 24-29.). Consumer variables include demographic and psychographic information about consumers, including vital statistics, likes, dislikes, lifestyle and behavioral characteristics, personality traits and preferences, etc. (Col. 3, lines 42-56).

Claim 35 patentably distinguishes over Dedrick because Dedrick does not disclose or suggest a method that includes all of the limitations recited in claim 35 for providing a user with access to selected ones of a plurality of target objects. In particular, Dedrick does not disclose or suggest “automatically generating target profiles for target objects that are stored in said electronic storage media, **each of said target profiles being generated from the contents of an associated one of said target objects and their associated sets of target object characteristics**”[emphasis added], as required by claim 35. Dedrick does not even disclose the concept of a target profile. The Office Action appears to contend that target profiles are taught in Dedrick in column 4, lines 11-67, and in particular that lines 16-18 and 44-50 of column 4 teach target profiles being generated from contents of target objects and their associated set of target object characteristics. However, these particular cited passages merely indicate that the electronic information of the content database may be formatted in a variety of ways, including audio, video, graphics, animation, text, etc. Formatting information is not generating a target profile *from contents* of the information, and a *format*

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of information is not a *profile* of information. Moreover, Dedrick does not teach or suggest that a format of information is based on the contents of the electronic information, much less also being based on *associated sets of target object characteristics*.

Further, embedding consumer variables within the electronic information (as described in col. 4 of Dedrick) is not generating target profiles from the content of the electronic information and associated sets of characteristics of the information. Rather, as is made clear throughout Dedrick, in particular in column 3 cited above, consumer variables are based on consumers, specifically demographic and psychographic information about consumers, not content of the electronic information.

In view of the foregoing, claim 35 patently distinguishes over Dedrick. Accordingly, Applicants respectfully request that the rejection of claim 35 under §103(a) be withdrawn. Claims 36-46 each depend from claim 35 and are patentable for at least the same reasons. Accordingly, Applicants respectfully request that the rejection of these claims be withdrawn.

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CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

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